

obviousness-type double patenting as allegedly being unpatentable over claims 2-8 and 16 of co-pending Application No. 10/361,505.

Applicants submit that this rejection lacks merit and should be withdrawn for the same reasons set forth at page 3 of the Response under 37 C.F.R. § 1.116 filed July 29, 2005.

While Applicants do not believe that the rejection has merit, to advance the prosecution, Applicants submit herewith a Terminal Disclaimer to obviate the rejection.

Reconsideration and withdrawal of the obviousness-type double patenting rejection based on the co-pending '505 Application is respectfully requested.

In Paragraph No. VI at pages 5-6 of the final Office Action mailed March 30, 2005, the elected invention of claims 2, 6, 9-10, 12, 17-20 and 21 was provisionally rejected for obviousness-type double patenting as allegedly being unpatentable over claims 17-20 of co-pending Application No. 10/613,044 as amended on February 22, 2005.

Applicants submit that this rejection lacks merit and should be withdrawn for the same reasons as set forth at pages 3-4 of the Response under 37 C.F.R. § 1.116 filed July 29, 2005.

While Applicants do not believe that the rejection has merit, to advance the prosecution, Applicants submit herewith a Terminal Disclaimer to obviate the rejection.

Reconsideration and withdrawal of the obviousness-type double patenting rejection of claims 2, 6, 9-10, 12, 17-20 and 21 based on the co-pending '044 Application is respectfully requested.

In Paragraph No. VII at pages 6-7 of the final Office Action mailed March 30, 2005, the elected invention of claims 2-4, 6, 9-10, 12, 17-20 and 21 was provisionally rejected for

obviousness-type double patenting as allegedly being unpatentable over claims 3-4, 6, 8, 11-12, 14, 16 and 18 of co-pending Application 10/654,942.

Applicants note that the '942 Application has now issued as U.S. Patent No. 6,902,862.

Applicants submit that the rejection lacks merit and should be withdrawn for the same reasons set forth at pages 4-5 of the Response under 37 C.F.R. § 1.116 filed July 29, 2005.

While Applicants believe the rejection lacks merit, to advance the prosecution, Applicants submit herewith a Terminal Disclaimer to obviate the rejection.

Reconsideration and withdrawal of the obviousness-type double patenting rejection of claims 2-4, 6, 9-10, 12, 17-20 and 21 based on the co-pending '942 Application (now U.S. Patent 6,902,862) is respectfully requested.

In Paragraph No. VIII at pages 7-9 of the Action, the elected invention of claims 2, 6, 9-10, 12, 17-20 and 21 "with respect to the elected and applied species" is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sinta et al. (5,731,364) and Sato et al. (6, 238,842).

Applicants submit that this rejection should be withdrawn because Sinta et al. '364 and Sato et al. '842 do not disclose or render obvious the positive resist composition of the present invention.

Independent claim 2 relates to a positive resist composition. The resist composition includes (A) an acid-generating compound which has a partial structure represented by formula (1) shown in claim 2; and a counter ion. The resist composition also includes (D) a resin capable of increasing its solubility in an alkali developer under the action of an acid. The resist

composition includes the compound (A) in an amount of from 3.6 to 15 wt% based on the solids content of the composition.

Claim 6, 9-10, 12 and 17-20 depend directly or indirectly from claim 2.

Claim 21, like claim 2, is an independent claim directed to a positive resist composition. Like the resist composition of claim 2, the resist composition of claim 21 includes (A) an acid-generating compound having a partial structure represented by formula (1) shown in claim 21.

Referring to Paragraph II of item 11 of the Advisory Action mailed August 12, 2005, Applicants note with appreciation the Examiner's agreement with Applicants that compound (A) in Sinta et al. is not within the scope of formula (1) in present claim 2. The Examiner now asserts, however, that compounds of the general formula (V) at column 2, line, 43-60 and column 3, lines 8-18 of Sinta "on the record" are "properly applied." With due respect, Applicants submit that the Examiner is not correct. The compounds of formula (V) of Sinta et al. are not within the scope of formula (1) of present claim 2, nor are the compounds of the structural formula at column 3, lines 8-18 of Sinta et al. relied upon by the Examiner.

Referring to formula (V) of Sinta et al., R_2 and R_2' are members of a first fused aryl ring, and R_3 and R_3' are members of a second fused aryl ring. Each X is independently a heteroatom.

What is meant by this description is perhaps more clearly seen in the structural formula at column 3, lines 8-18 of Sinta et al. Upon review of the structural formulas of Sinta et al. and a comparison to formula (1) in present claim 2 and the compounds shown beginning at page 22 of the present application, it is clear that the compounds of Sinta et al. are not within the scope of

formula (1) of the present application. The compounds of Sinta et al. have a pair of opposed aryl rings which are bridged by a heteroatom, unlike the compounds of formula 1 of the present application, which do not include a heteroatom "bridge".

For the above reasons, Sinta et al. '364 does not disclose or render obvious the compound having a partial structure represented by formula (1) in the present claims and thus does not disclose or render obvious the positive resist composition of the present invention. Sato et al. '842 is relied upon solely for its disclosure of the use of a nitrogen-containing basic compound, see the third full paragraph at page 8 of the final Office Action, and does not make up for the deficiencies of Sinta et al. '364.

In view of the above, Applicants respectfully request reconsideration and withdrawal of the § 103 rejection of claims 2, 6, 9-10, 12, 17-20 and 21 based on Sinta et al. '364 in view of Sato et al. '842.

In Paragraph No. IX at pages 9-10 of the final Office Action, the elected invention of claims 2, 6, 9-10, 12, 17-20 and 21 with respect to the elected and applied species is rejected under

35 U.S.C. § 103(a) as allegedly being unpatentable over Inoue et al. (6,406,830).

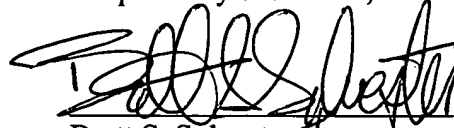
Referring to Paragraph III in item No. 11 of the Advisory Action mailed August 12, 2005, Applicants note with appreciation that the §103 rejection based on Inoue et al. '830 has been withdrawn in view of Applicants' Response under 37 C.F.R. § 1.116 filed July 29, 2005.

Supplemental Response
U.S. Application No. 10/606,845

Attorney Docket No. Q76336

In view of the above, allowance is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Brett S. Sylvester", written over a horizontal line.

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